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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,205	05/25/2001	Shea Chen	004578.1123	4344

7590 10/27/2003
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EXAMINER

LUEBKE, RENE S

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/866,205	CHEN & PILLANS & EHMKE & YAO	
Examiner	Art Unit	
Renee S. Luebke	2833	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-11, 14-16, 18-21 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 25-36 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-9, 11, 15, 16, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 14 21 37 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 4, 6, 7, 9 and 11 remain rejected under 35 U.S.C. 102(b) as being anticipated by Oelsch. This apparatus comprises a switch with a base section 1, 2, an electrically conductive part 5 on the base section, and a membrane 3. The membrane has ends (to the right of 8 and to the left of 7) supported at locations on the base, an electrically conductive portion 6 between the ends, first and second U-shaped sections 7, 8, and outer portions that extend outwardly from one of the sections (see fig. 1). The sections serve as resilient structure *capable* of yieldably varying in size as claimed.

Applicant argues that the sections of Oelsch do not experience any resilient change in shape when the length of the membrane increases, and generally argues that the description of Oelsch teaches away from the claimed invention. However, the membrane of Oelsch that forms the sections is "a flexible, elastic switching film" (col. 1, line 11). Given this, it meets the limitation that the sections "serve as resilient structure" in claim 1. The remainder of the statement in the claim is that this structure be "capable of yieldably varying in size." To be capable of something does not require or imply that it actually occur. It merely must be possible. In the present case, a flexible, elastic structure is inherently *capable* of yieldably varying in size, as that is the definition of elastic. Therefore, the sections of Oelsch "serve as resilient structure capable of yieldably varying in size" as claimed.

3. Claims 2, 8, 15, 16, 18 and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Oelsch in view of Randall, et al. for the reasons discussed in the previous Office action and above.

4. Claims 10, 20 and 25-36 are allowed.

Claims 14, 21, 37 and 38 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. **It is suggested that responses to this final action be faxed to:**
(703) 872-9306

Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

Alternatively, responses may be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

Hand-delivered responses should be brought to:

Crystal Plaza 4, Fourth Floor (Receptionist)
2201 South Clark Place, Arlington, Virginia.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (703) 308-2319.

A handwritten signature in black ink, appearing to read 'R. Luebke', with a stylized flourish at the end.

Renee S. Luebke
Primary Patent Examiner
August 4, 2002